APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,088	11/20/2003	Scott Robert Hinkelman	AUS920030897US1	9422

46073   7590   06/13/2008
IBM CORPORATION (VE)
C/O VOLEL EMILE
P. O. BOX 162485
AUSTIN, TX 78716

EXAMINER
NGUYEN, THUY-VI THI

ART UNIT	PAPER NUMBER
3689	

MAIL DATE	DELIVERY MODE
06/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	**Applicant(s)**
	10/718,088	HINKELMAN, SCOTT ROBERT
Office Action Summary	**Examiner**	**Art Unit**	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20080527

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1-5 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

3.   An example of a method claim that would <u>not </u>qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-5 are non-statutory since

they may be performed within the human mind.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Lucas at al (2003/0070158). Herein after is referred as Lucas.

    Regarding claim 1, Lucas discloses a method of receiving a document by a

party, the party having a set of policies, the method comprising the steps of:

        receiving the document [...figure 2; par. 0056, lines 1-5; pars. 0060, 0061];

        automatically determining whether the document contains at least one

standardized specification conformance statement [...*i.e. verify whether the XML

processing code is valid, and whether the XML being produced conforms to

manufacturing community's specification*; pars. 0060, 0061; figure 8A-8B]; and

         automatically verifying, if the document contains the at least one

standardized specification conformance statement, that information relating to the

statement is conformant to the standardized specification as well as to the set of

policies of the party [...*i.e. verify whether the XML processing code is valid, and

whether the XML being produced conforms to manufacturing community's

specification*; pars. 0060, 0061; figure 8A-8B].

Regarding claim 2, Lucas discloses wherein the verifying step includes the

step of accessing the standardized specification and the policies for verification

[...*i.e. verify that each of these operations is allowable and consistent with the*

AvailableAt XML data type defined in the file "AvailableAT.xsd"; figures 8A-8B; par.

0060, 0061 lines 21-24].

Regarding claim 3, Lucas discloses wherein the verifying step includes the

step of accessing a conformance model for verification [...a conformance model for

verification such as *AvailableAt XML data type*; figures 8A-8B; par. 0060, 0061 lines

21-24].

Regarding claim 4, Lucas discloses wherein the conformance model

includes at least one conformance statement required in the document [figures 8A-

8B; par. 0060, 0061 lines 21-24].

Regarding claim 5, Lucas discloses wherein the conformance model

includes a plurality of conformance statements in a sequence that is required to be

in the document in the same sequence [...statement (830); figure 8A; figure 8B;

pars. 0060, 0061].

Regarding claim 6, Lucas discloses a computer program product on a

computer readable medium for facilitating a party to receive a document,

the party having a set of policies, the computer program product comprising:

code means for receiving the document [...figure 2; par. 0056, lines 1-5; pars.

0060, 0061];;

code means for automatically determining whether the document contains at least one standardized 15 specification conformance statement [*...i.e. verify whether the XML processing code is valid, and whether the XML being produced conforms to manufacturing community's specification*; pars. 0060, 0061; figure 8A-8B]; and

code means for automatically verifying, if the document contains the at least one standardized specification conformance statement, that information relating to the statement is conformant to the standardized specification as well as to the set of policies of the party [*...i.e. verify whether the XML processing code is valid, and whether the XML being produced conforms to manufacturing community's specification*; pars. 0060, 0061; figure 8A-8B].

Regarding claim 7, Lucas discloses a wherein the verifying code means includes code means for accessing the standardized specification and the policies for verification [*...i.e. verify that each of these operations is allowable and consistent with the AvailableAt XML data type defined in the file "AvailableAT.xsd"*; figures 8A-8B; par. 0060, 0061 lines 21-24].

Regarding claim 8, Lucas discloses wherein the verifying code means includes code means for accessing a conformance model for verification [...a conformance model for verification such as *AvailableAt XML data type*; figures 8A-8B; par. 0060, 0061 lines 21-24].

Regarding claim 9, Lucas discloses wherein the conformance model includes at least one conformance statement required in the document [figures 8A-8B; par. 0060, 0061 lines 21-24].

Regarding claim 10, Lucas discloses wherein the conformance model includes a plurality of conformance statements in a sequence that is required to be in the document in the same sequence [...statement (830); figure 8A; figure 8B; pars. 0060, 0061].

Regarding claim 11, Lucas discloses an apparatus for receiving a document by a party, the party having a set of policies, the apparatus comprising:

means for receiving the document [...figure 2; par. 0056, lines 1-5; pars. 0060, 0061];

means for automatically determining whether the document contains at least one standardized specification conformance statement [...*i.e. verify whether the XML processing code is valid, and whether the XML being produced conforms to manufacturing community's specification*; pars. 0060, 0061; figure 8A-8B]; and

means for automatically verifying, if ,the document contains the at least one standardized specification conformance statement, that information relating to the statement is conformant to the standardized specification as well as to the set of policies of the party [...*i.e. verify whether the XML processing code is valid, and whether the XML being produced conforms to manufacturing community's specification*; pars. 0060, 0061; figure 8A-8B].

Regarding claim 12, Lucas discloses wherein the verifying means includes means for accessing the standardized specification and the policies for verification [...*i.e. verify that each of these operations is allowable and consistent with the*

AvailableAt XML data type defined in the file "AvailableAT.xsd"; figures 8A-8B; par.
0060, 0061 lines 21-24].

Regarding claim 13, Lucas discloses wherein the verifying means includes
means for accessing a conformance model for verification [...a conformance model
for verification such as *AvailableAt XML data type*; figures 8A-8B; par. 0060, 0061
lines 21-24].

Regarding claim 14, Lucas discloses wherein the conformance model
includes at least one conformance statement required in the document [figures 8A-
8B; par. 0060, 0061 lines 21-24].

Regarding claim 15, Lucas discloses wherein the conformance model
includes a plurality of conformance statements in a sequence that is required to be
in the document in the same sequence [...statement (830); figure 8A; figure 8B;
pars. 0060, 0061].

Regarding claim 16, Lucas discloses a system for receiving a document by a
party, the party having a set of policies, the system comprising:

at least one storage device for storing code data [figure 6; storage (606); par.
0064]; and

at least one processor for processing the code data to receive the document
[...figures 2 and 6, processors; (602); par. 0064, figures 2, par. 0056, lines 1-5] to
automatically determine whether the document contains at least one standardized
specification conformance statement, and to automatically verify, if the document
contains the at least one standardized specification conformance statement, that

information relating to the statement is conformant to the standardized specification
as well as to the set of policies of the party [...*i.e. verify whether the XML processing
code is valid, and whether the XML being produced conforms to manufacturing
community's specification*; pars. 0060, 0061; figure 8A-8B].

      Regarding claim 17, Lucas discloses wherein the code is further processed
to access the standardized specification and the policies for verification [...*i.e. verify
that each of these operations is allowable and consistent with the AvailableAt XML
data type defined in the file "AvailableAT.xsd"*; figures 8A-8B; par. 0060, 0061 lines
21-24].

      Regarding claim 18, Lucas discloses wherein the code is further processed
to access a conformance model for verification [...a conformance model for
verification such as *AvailableAt XML data type*; figures 8A-8B; par. 0060, 0061 lines
21-24].

      Regarding claim 19, Lucas discloses wherein the conformance model
includes at least one conformance statement "required in the document [figures 8A-
8B; par. 0060, 0061 lines 21-24].

      Regarding claim 20, Lucas discloses wherein the conformance model
lincludes a plurality of conformance statements in a sequence that is required to be
in the document in the same sequence [...statement (830); figure 8A; figure 8B;
pars. 0060, 0061].

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7.   The US Patent Application to Dreyband et al. disclose a method and apparatus for mapping a descriptive language including a data description having a structure complexity into an object oriented data presentation includes identifying the data description; and to Berg discloses a method and apparatus for synchronizing an XML document with its object model.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

/T. N./

Examiner, Art Unit 3689

/Dennis Ruhl/

Primary Examiner, Art Unit 3689